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PTO/SB/33 (07-05)

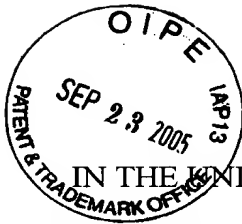
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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 031792-0311520 | | | | | | | | | |
|---|---|---|--|--|---|---|---|--|---|---|------------------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____ | Application Number 09/315,822 | Filed May 21, 1999 | | | | | | | | | |
| | First Named Inventor CHRISTENSEN | | | | | | | | | | |
| | Art Unit 3622 | Examiner Jean D. Janvier | | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td> Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Anita Choudhary Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 56520</td><td>703-905-2166 Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>9-23-05 Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</p> | | | | <input type="checkbox"/> applicant/inventor. |  Signature | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | Anita Choudhary Typed or printed name | <input checked="" type="checkbox"/> attorney or agent of record. Registration number 56520 | 703-905-2166 Telephone number | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | 9-23-05 Date |
| <input type="checkbox"/> applicant/inventor. |  Signature | | | | | | | | | | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | Anita Choudhary Typed or printed name | | | | | | | | | | |
| <input checked="" type="checkbox"/> attorney or agent of record. Registration number 56520 | 703-905-2166 Telephone number | | | | | | | | | | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | 9-23-05 Date | | | | | | | | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
CHRISTENSEN

Confirmation Number: 6988

Application No.: 09/315,822

Group Art Unit: 3622

Filed: May 21, 1999

Examiner: Jean D. Janvier

Title: VIRTUAL COUPONING METHOD AND APPARATUS FOR USE WITH CONSUMER KIOSK

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed July 26, 2005, Applicant requests review of the final rejection in the above-identified application. This request is being concurrently filed with a Notice of Appeal. The review is requested for the reasons provided in the **Remarks** beginning below. A total of 5 pages are provided.

No additional fees are believed necessary. If any extensions of time are necessary to prevent abandonment, they are hereby petitioned for under 37 C.F.R. § 1.136(a). If any fees are required for any purpose, authorization to charge our Deposit Account No. 033975 (*Ref. No. 031792-0311520*) is hereby granted.

Remarks

Claims 1-16, 19, and 24-27 stand rejected under 35 U.S.C. §102(e) as being unpatentable over Barnett et al., U.S. Patent 6,321,208 ("Barnett"). Applicant traverses this rejection on at least the following basis. Applicant does not necessarily agree with all of the Examiner's characterizations of Barnett. It is unnecessary at this time to address all of these issues. Simply put, the Examiner has failed to show that Barnett teaches each and every claim feature as required in an anticipation rejection under 35 U.S.C. §102(e). Barnett fails to disclose at least the following claim features of an in-store redemption system: "*means, located at a retail location, for accessing the database...a printer, located at the retail location...redemption means, at the retail location, including a scanner for scanning coupons at the retail location checkout and means for determining if a coupon presented by*

consumer is valid prior to crediting the consumer a redemption value associated with the coupon” (emphasis added).

The Examiner acknowledges that Barnett fails to expressly disclose a system at a retail location, as claimed. *See* Final Action of July 26, 2005 at pg. 6, lines 1-4. The Examiner then attempts to combine the features of Barnett with a separate patent to Spector (U.S. 5,176,224). Spector is mentioned in the background of Barnett. However, this purported combination is inappropriate in a rejection based on *anticipation* under 35 U.S.C. § 102(e). The Examiner cites no legal support for properly combining references in this way under section 102.

Even if the references could be combined under section 103 (which is not admitted), the combination would not preclude patentability. Neither Barnett nor Spector discloses, among other things, “scanning coupons at the retail location checkout and means for determining if a coupon presented by consumer is valid prior to crediting the consumer with a redemption value associated with the coupon,” as recited in each of independent claims 1, 11, and 16.

In the Final Action, the Examiner alleges, without support, that Barnett discloses: “when a duplicate of the coupon, that is already redeemed, is presented for subsequent redemption, the system is operable to validate or verify in real-time the authenticity of the presented (duplicate) coupon before crediting the customer’s order.” *See* Final Action at pg 25, lines 18-20. Barnett does not disclose this. Rather, among other things, Barnett discloses:

Thus, any attempts to duplicate via photocopying techniques any particular coupon will be discouraged since *the coupon redemption center* will detect when a particular coupon has been redeemed, will identify the user who redeems a particular coupon, and will disallow any attempt at redemption of a second coupon with identical product and user-specific data. **Col. 5 lines 56-61**

The unique user bar code 90 also renders the electronic coupon system of the present invention secure and virtually fraud-proof. Although a user is able to print out a particular coupon 18 only once, the coupon issuer 14 could still be defrauded by a user or retailer who might photocopy a printed coupon numerous times and fraudulently and repeatedly present it for redemption. However, in accordance with the present invention, each coupon printed by a user is unique, and the scanning of a coupon presented for redemption will be stored at the coupon redemption center. Thus, the coupon issuer will know if a particular user has redeemed a particular coupon and thus disallow further

redemption of a photocopied coupon bearing the same indicia. **Col. 11 lines 10-23.**

This scanning occurs at a redemption center (13) *after* the coupon has been redeemed by the consumer and the coupon is sent by the retailer (10) to a traditional coupon redemption center (13). In Barnett, the retail checkout (10) allows the consumer to receive the coupon discount without first validating the coupon. Only after the coupon discount is credited to the consumer and the coupon is sent to the coupon redemption center (13) does the coupon get scanned. The coupon issuer (14) can *disallow redemption by the retailer* of a duplicate coupon, to prevent fraud. Specifically, Barnett recites:

The printed coupons 18 are used in the normal fashion by a consumer when shopping at a desired retail store 10. That is, the coupons 18 are presented to a product checkout station 11 along with the associated products for purchase, and the discount amount shown on the coupon 18 is credited to the consumer at the point of sale. *The redeemed coupons 18 are transmitted to a coupon redemption center 13 where they are electronically read*, and user-specific data is stored in a coupon redemption database 12. **Col. 7 lines 12-20 (emphasis added)**

Thus, neither Barnett nor Spector disclose “redemption means, at a retail location” or “means for determining if a coupon...is valid prior to crediting the consumer.” For at least the reasons above, the rejection of claims 1-16, 19, and 24-27 over Barnett is clearly improper and must be withdrawn.

Claims 1, 4, 9, 10, 11-16 and 24-27 stand rejected under 35 U.S.C. §102(e) as being unpatentable over Lemon et al., U.S. Patent 4,674,041 (“Lemon”). This rejection is legally deficient for at least the following reasons. Lemon fails to disclose, among other thing, “redemption means, at the retail location, including a scanner for scanning coupons at the retail location checkout and means for determining if a coupon presented by consumer is valid prior to crediting the consumer,” as recited in each independent claim (1, 11, and 16). The Examiner alleges that: “Lemon silently supports the step of validating a coupon.” *See* Final Action, pg. 25 lines 4-5. Silently or otherwise, Lemon does not disclose these claim features. The majority of the Lemon reference addresses the dispensing of coupons, not the redemption by a consumer. In passing, Lemon indicates that:

Furthermore, electronically readable uniform product codes may be included on the coupon in the same fashion as the expiration dates or other data specified herein so that an appropriately programmed check out register can read the product code on the coupon and apply the coupon discount only if a product bearing the identical product code has been purchased. This feature

prevents customers from overwhelming the store's employees with a large number of coupons and groceries at peak business hours to obtain the benefit of the coupon discount without purchasing the corresponding product. **Col. 6 lines 40-47**

As stated in the previous Response, Lemon discloses that a checkout register can read the product code on the coupon and apply the coupon discount only if the product bearing the identical product code has been purchased. *See* Lemon col. 6, lines 40-47. As such, Lemon merely determines if *a product* related to the coupon is being purchased and eligible for a discount. This does not determine if the coupon itself is fraudulent or invalid. For example, if the coupon is invalid, Lemon will not first determine this by scanning the coupon at the checkout.

In contrast, the present invention recognizes the desirability of determining if a product being purchased is eligible for a coupon but separately determines if the coupon itself is valid. The Specification clearly distinguishes between the two by stating:

The SELLECTSOFT™ database repository 126 may be utilized to redeem Virtual Coupons™ in real time at a retail location during checkout. A UPC product code may be scanned electronically during checkout, and data from the SELLECTSOFT™ database may be reviewed to determine whether such a product is eligible for Virtual Coupon.™ discount redemption. *If a consumer attempts to redeem too many of a particular Virtual Coupon™, authorization to redeem such Virtual Coupons™ may be denied (emphasis added).* **Page 45 lines 15-22.**

Thus, the present invention not only checks product eligibility, but also validates the coupon itself (e.g. based on attempts to redeem). This latter feature relates to the claim element at issue.

The Examiner's allegation, that Lemon may be configured to prevent a user from using the same credit card to *download* the same coupon more than a number of times misses the point. This relates to dispensing coupons, not to redeeming coupons as claimed. For at least these reasons, the rejection of claims 1, 4, 9, 10, 11-16 and 24-27 based on Lemon is improper and must be withdrawn.

Claims 16-27 stand rejected under 35 U.S.C. §102(e) as being unpatentable over Powell et al., U.S. Patent 5,887,271 ("Powell"). Applicant traverses this rejection on at least the following basis. Powell fails to disclose, among other things, "scanning coupons at the retail location checkout and...determining if a coupon presented by consumer is valid prior to crediting the consumer a redemption value associated with the coupon," as recited in

independent claim 16. Powell discloses determining which discounts should be applied based simply on whether a scanned product matches a UPC on a discount list stored in a card. *See* Powell col. 7, lines 42-48. Thus, Powell does not validate a coupon itself. If, for example, a coupon is fraudulently deposited onto the card, Powell does not disclose that it will determine this by scanning the coupon at checkout. For at least these reason, the rejection of claims 16-27 is improper and must be withdrawn.

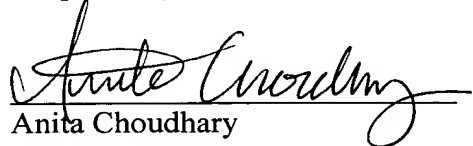
Claim 18 stands rejected under 35 U.S.C. §112, first paragraph, for “printing means for printing a temporary frequency card.” Applicant traverses this rejection on at least the following basis. The Examiner acknowledges that the specification discloses using a coupon list as a temporary frequency card. *See* Final Action, page 2, last paragraph. Applicant’s Specification further discloses the coupon list can be printed using a printing means. *See* Specification at pg. 30, line 27- pg. 31, line 9 and pg. 32, lines 3-5. Since the printed coupon list may be used as a temporary frequency card, as acknowledged by the Examiner, the Specification does have support. For at least this reason, the rejection of claim 18 is improper and must be withdrawn.

If, for any reason, a personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: September 23, 2005

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Respectfully submitted,


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